



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/705,927

11/06/2000

David D. Kloba

1933.0010009

8134

26111

7590

05/01/2006

STERNE, KESSLER, GOLDSTEIN & FOX PLLC  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

FABER, DAVID

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/705,927

Applicant(s)

KLOBA ET AL.

Examiner

David Faber

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/19/01, 4/3/02, 8/21/03, 2/5/04, 6/31/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to the application 6 November 2000.

**This office action is made Non-Final.**

2. Claims 1-27 are pending. Claims 1, 10, and 19 are independent claims.

### ***Information Disclosure Statement***

3. The information disclosure statement filed 9/19/2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because Page 2 - Other Art: AR2, Page 9 - Other Art: AT9, Page 11 - Other Art: AR11, Page 18 - Other Art: AR18 and AT18, Page 23 - Other Art: AT23, Page 27 - Other Art: AS27, Page 29 - Other Art: AT29, Page 30 - Other Art: AR30, Page 31 - Other Art: AT31, Page 34 - Other Art: AT34, Page 36 - Other Art: AS36, and Page 37 - Other Art: AR37 fail to list the pertinent page(s) of the source. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).
4. The information disclosure statements (IDS) submitted on 3 April 2002, 21 August 2003, 5 February 2004, and 31 August 2004 are in compliance with the

provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

5. The drawings are objected to because Examiner had a hard time locating all reference numbers and objects on FIG 1 due to the clustering of all objects and numbers positioned together. Examiner suggests using the method of how FIG 1B was created on redrawing FIG 1A. In addition, FIG 1B1 shows handwritten words misspelled and not written in a clean, professional manner, FIG 1H text is small making it hard to read when trying to follow along the chart. Also, drawings 2I1, 2I2, and 3G are unreadable when scanned to the Examiner. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the

Art Unit: 2178

changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 100 of FIG. 1B; 206E2, 106F2, 206G2, 206 H2, and 206J2 of FIG. 2F2; and 207E and 207G of 2G. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2178

8. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 1, 3-5, 9-10, 12-14, 18-19, 21-23 and 27 recite the term "mutable document" within the limitations. Examiner is unsure what Applicant means by the term by mutable, and unable to find a clear definition of the use of the term. Therefore, Examiner will view the term "mutable" being as changeable, throughout this Office Action.

10. Any claim not specifically addressed, above, is being rejected as incorporating the deficiencies of a claim upon which it depends.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-3, 10-12, and 19-21 rejected under 35 U.S.C. 102(e) as being anticipated by Whitledge et al (US Patent #6,925,595, filed 10/5/1998)

As per independent Claim 1, Whitledge et al discloses a method comprising:

- Determining layout and rendering parameters based on mobile device information (e.g., Column 8, lines 5-15: Discloses obtaining device-conversion preferences that are to be used to convert an original electronic document into converted electronic document that would allow it to be displayed on a smaller display with a lower resolution, which includes a PDA (Column 21, lines 1-2) The device-conversion preferences would inherently describe the specifications of the display screen of the device which in other words, disclose the resolution, screen size and video information. )
- Parsing requesting content into a mutable document having a format based on at least said layout and rendering parameters. (Column 8, lines 19-27: Discloses converting content based on preferences into a document. One embodiment includes parsing content into a document that includes converting the content based on the conversion preferences. (Column 23, lines 9-40; FIG 8B)
- Generating a mutable document content on an object-by-object basis from said mutable document. (Column 21, line 11 - Column 23, lines 40; FIG 8B: Discloses conversion of objects into a converted document by per object including changing each text element to Arial, and change the color and size of the image.)
- Generating a mutable document table based on said object-by-object basis for said mutable document content. (Column 24, lines 35-40: Discloses in a embodiment where selected, wherein selected can be all, hypertext elements

references are saved into a symbol table so they can be used in other expression or documents.

As per dependent Claim 2, Whitledge et al discloses a method wherein said object-by-object basis corresponds to distinguishable pieces of request content. (Column 21, line 11 - Column 23, lines 40; FIG 8B: Discloses different objects, text and images, are identified as text and images making them distinguishable.)

As per dependent Claim 3, Whitledge et al discloses a method wherein said mutable document table provides points of reference to the objects of said document content (Column 24, lines 35-40: Discloses in an embodiment where selected, wherein selected can be all, hypertext elements references (points to the elements) are saved into a symbol table so they can be used in other expression or documents.

As per independent claim 10, Claim 10 recites a system for performing the method of Claim 1 and is similar rejected under rationale.

As per dependent claim 11, Claim 11 recites similar limitations as in Claim 2, and is similarly rejected under rationale.

As per dependent claim 12, Claim 12 recites similar limitations as in Claim 3, and is similarly rejected under rationale.

As per independent claim 19, Claim 19 recites a computer program product... for performing the method of Claim 1 and is similar rejected under rationale.



As per dependent claim 20, Claim 20 recites similar limitations as in Claim 2, and is similarly rejected under rationale.

As per dependent claim 21, Claim 21 recites similar limitations as in Claim 3, and is similarly rejected under rationale.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 4, 13, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitley et al (US Patent #6,925,595, filed 10/5/1998) in further in view of Barron (US Patent #6,665,709, filed 3/27/2000).

As per dependent Claim 4, Whitley et al discloses compressing said mutable document content according to said object-by-object basis (Column 23, lines 9-54: Discloses image size being reduced or compressed of its original size to be able to meet the conversion preferences.)

However, Whitley et al fails to specifically disclose encrypting said mutable document content according to said object-by-object basis. However, Barron discloses a method of encrypting electronic data into an encrypted data packet. (Column 6, Claim 1, line 48-49).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Whitley et al's method with Barron's method since Barron's method would have facilitated virtually impregnable security for the delivery, storage and sharing of documents and files.

As per dependent claim 13, Claim 13 recites similar limitations as in Claim 4, and is similarly rejected under rationale.

As per dependent claim 22, Claim 22 recites similar limitations as in Claim 4, and is similarly rejected under rationale.

16. Claims 5-8, 14-17, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitley et al (US Patent #6,925,595, filed 10/5/1998) in further view of Barron (US Patent #6,665,709, filed 3/27/2000) in further view of Burkett et al (US Patent #6,671,853, filed 7/15/1999)

As per dependent Claim 5, Whitley et al and Barron fail to specifically disclose serializing said mutable document content into a content stream according to said object-by-object basis and serializing said mutable document table into said content stream according to said object-by-object basis for said mutable document, wherein said mutable document content and said mutable document table form said content stream according to said mobile device information. However, Burkett et al discloses parsing a document into DOM trees and having the tree be streamed into a binary format in which the streamed objects are known as serialized objects. In addition, any embedded or referenced objects are processed recursively during the process. When

Art Unit: 2178

finished, the stream is written onto a communications channel. (Column 3, lines 1-26; line 64 – Column 4, line 2) Whitledge et al discloses an embodiment in by parsing a document first into a DOM tree, and creating a table comprising object references before converting the document. (FIG 9-12, Column 24, lines 9- Column 25, lines 67)

It would have been obvious to one of ordinary skill in the art at the Applicant's invention to have combined Whitledge et al and Barron methods with Burkett et al's methods since Burkett et al's method would have provided the benefit of wherein documents encoded can be more efficiently processed.

As per dependent Claim 6, Whitledge et al discloses said transmitting said content stream to a mobile device. (Column 8, lines 29-34, 40-47)

As per dependent Claim 7, Whitledge et al discloses said storing said content stream to a mobile device. (Column 8, lines 29-34; 40-47: Discloses receiving a converted document wherein when the document is received, its inherently saved to temporary memory buffer for further operation.)

As per dependent Claim 8, Claim 8 recites similar limitations as in Claim 2 and Claim 5 and is rejected under rationale. Furthermore, Whitledge et al discloses a method comprising modifying an object of said content stream, wherein said object corresponds to distinguishable pieces of said requested content. (Column 23, lines 9-54: Discloses content, such as image, being altered or modify to accustom to the PDA device conversion preferences during the process being received by the PDA.)

As per dependent claim 14, Claim 14 recites similar limitations as in Claim 5, and is similarly rejected under rationale.

As per dependent claim 15, Claim 15 recites similar limitations as in Claim 6, and is similarly rejected under rationale.

As per dependent claim 16, Claim 16 recites similar limitations as in Claim 7, and is similarly rejected under rationale.

As per dependent claim 17, Claim 17 recites similar limitations as in Claim 8, and is similarly rejected under rationale.

As per dependent claim 23, Claim 23 recites similar limitations as in Claim 5, and is similarly rejected under rationale.

As per dependent claim 24, Claim 24 recites similar limitations as in Claim 6, and is similarly rejected under rationale.

As per dependent claim 25, Claim 25 recites similar limitations as in Claim 7, and is similarly rejected under rationale.

As per dependent claim 26, Claim 26 recites similar limitations as in Claim 8, and is similarly rejected under rationale.

***Allowable Subject Matter***

17. Claims 9, 18, and 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kanevsky (US Patent 6,300,947): Discloses the ability of a web page adjust to comply with multiple visual and mobile devices.
- Gerard et al (US Patent 6,023,704): Discloses the functionality of pointers referencing to objects.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/705,927

Page 13

Art Unit: 2178

David Faber  
Patient Examiner  
AU 2178

DF

  
STEPHEN HONG  
SUPERVISORY PATENT EXAMINER